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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/900,084 | 07/05/2001 | Nelson R. Holcomb | 10010372-1 | 5860 |

7590 06/03/2003
AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER

CHAKRABARTI, ARUN K

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| ART UNIT | PAPER NUMBER |
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1634

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/900,084

Applicant(s)

Holcomb

Examiner

Arun Chakrabarti

Art Unit

1634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED May 9, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

The request for reconsideration filed on May 9, 2003, has been considered but does not place the application in condition for allowance because of the following reasons:

Applicant argues (page 7, line 1 to page 13, line 13) that 102(a) rejection of claims 20-22, 25, 28, 31 and 50 based on Goldberg reference should be withdrawn because Goldberg does not teach the main feature of the invention “adsorbed polymer surface on a siliceous substrate”.

Applicant also argues (page 12, first paragraph) that Goldberg teaches only covalent attachment of silane to siliceous substrate, whereas the applicant’s invention is an electrostatic interaction or other noncovalent attachments. These arguments are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an electrostatic interaction or other noncovalent attachments of polymer to siliceous substrate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Neither the claim nor the specification defines or discloses the explanation of the term “adsorbed polymer surface”. In absence of a clear definition of the term “adsorbed polymer surface”, the attorney’s arguments cannot be considered as evidence against the closest prior art. Moreover, MPEP 2111 states, “Claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification”. Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than it is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)”. In this case, glass substrate of Goldberg can be considered itself as a polymer or the combination of polystyrene or polytetrafluoroethylene with

silicon or glass (as taught by Goldberg in Column 3, lines 34-39) can be considered broadly as “adsorbed polymer surface on a siliceous substrate”. Therefore, 102(a) rejection is hereby properly maintained.


Applicant also argues (page 13, last paragraph to page 14, first paragraph) that 103 (a) rejection of claims 23, 24, and 32-35 based on Goldberg and Reynolds et al reference should be withdrawn because primary reference Goldberg is neither anticipatory nor obvious. This argument is not persuasive. As mentioned above in paragraph 2 that Goldberg reference clearly anticipates the invention as claimed in the independent claims 20-22, 25, 28, 31 and 50. Therefore, 103(a) rejection based on Reynolds is hereby properly maintained.

Applicant also argues (page 16, last paragraph to page 17, first paragraph) that 103 (a) rejection of claims 26-27 based on Goldberg and Cohen reference should be withdrawn because primary reference Goldberg is neither anticipatory nor obvious. This argument is not persuasive. As mentioned above in paragraph 2 that Goldberg reference clearly anticipates the invention as claimed in the independent claims 20-22, 25, 28, 31 and 50. Therefore, 103(a) rejection based on Cohen is hereby properly maintained.

Applicant also argues (page 17, last paragraph to page 18, first paragraph) that 103 (a) rejection of claims 29-30 based on Goldberg and McDonough et al reference should be withdrawn because primary reference Goldberg is neither anticipatory nor obvious. This argument is not persuasive. As mentioned above in paragraph 2 that Goldberg reference clearly anticipates the invention as claimed in the independent claims 20-22, 25, 28, 31 and 50. Therefore, 103(a) rejection based on McDonough et al. is hereby properly maintained.

Applicant also argues (page 16, lines 4-12, page 17, lines 3-15 and page 18, lines 12-16) that all 103(a) rejections should be withdrawn in view of the unexpected results of this invention.

This argument is not persuasive because of two reasons. (1) The only unexpected result disclosed is described on page 27, Table 3 showing delamination of adsorbed polymer surface using example hybridization solution compared to conventional SSC buffer in percent. The standard deviation of the data of both the preferred buffer and conventional SSC is much bigger than the mean data, which is not reliable as an unexpected result. (2) Moreover, the unexpected result must always be compared to the closest prior art. In this case the closest prior art is Goldberg reference. In absence of any comparison with Goldberg's results, it is impossible to determine the merits of the allegedly unexpected results. Therefore, all 103(a) rejections are hereby properly maintained.


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